

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re US Patent Application of:	)	
	)	
Phillip Craig GRAVES	)	
	)	
Application No.: 10/655,828	)	Group Art Unit: 3695
	)	
Filing Date: September 5, 2003	)	Examiner: Narayanswamy SUBRAMANIAN
	)	Petitions Officer: Alicia Kelley
Attorney Docket No.: 62941.002015	)	Petitions Examiner: Liana Walsh
	)	
Title: SYSTEM AND METHOD FOR	)	Confirmation No. 7150
SECURELY AUTHORIZING AND	)	
DISTRIBUTING STORED-VALUE	)	
CARD DATA	)	

**MAIL STOP PETITION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RENEWED PETITION UNDER 37 C.F.R. 1.78(a)(3)**  
**FOR CORRECTION OF PRIORITY CLAIM UNDER 35 U.S.C 120**

Dear Sir:

Following a Petition Under 37 C.F.R. 1.78(a)(3) filed on July 8, 2010 and the Decision on Petition under 37 C.F.R. 1.78(a)(3) and 37 C.F.R. 1.78(a)(6) mailed on September 16, 2010,<sup>1</sup> please find below a Renewed Petition Under 37 C.F.R. 1.78(a)(3). It has come to our attention that the above-identified application ("Application") might be considered to have an incomplete priority claim under 35 U.S.C. 120. The Applicants respectfully petition for modification of said priority claim under 37 C.F.R. 1.78(a)(3). To meet the requirements of that provision, the Applicants provide the following:

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<sup>1</sup> Attached hereto as Appendix I

**(1) The Reference Required by 35 U.S.C. 120 and paragraph (a)(2)**

The Application is a continuation-in-part of U.S. Patent Application Serial Number 10/411,971, filed April 11, 2003, now U.S. Patent No. 7,083,084, which is a continuation of U.S. Patent Application Serial Number 09/641,363, filed August 18, 2000, now U.S. Patent No. 6,575,361, which claims priority to U.S. Provisional Patent Application No. 60/149,740 filed August 19, 1999.

In correction of the noted error in the original Petition, an amendment to the specification in compliance with 37 C.F.R. 1.121, 1.52, and 1.4(c) is being submitted concurrently herewith.

**(2) The Surcharge Set Forth in 37 C.F.R. 1.17(t)**

Payment of the Petition Fee in the amount of \$1410.00 as set forth under 37 C.F.R. 1.17(t) was filed on July 8, 2010. If renewed payment of the Petition Fee is required, the Office is hereby authorized to deduct the Petition Fee and any other Fees from Deposit Account No. 50-5163.

**(3) Statement That Entire Delay Was Unintentional**

The Applicants' undersigned representative states that to the extent there was an insufficient claim of priority, the entire delay between the date the claim of priority was due under 37 C.F.R. 1.78(a)(2)(ii) and the filing of this petition under 37 C.F.R. 1.78(a)(3) was unintentional.

The unintentional nature of the delay is due to the Applicants' belief that a proper priority claim under 37 C.F.R. 1.78 had been made, and Applicant has only recently learned that a deficiency in the priority claim may exist. This belief is evidenced by at least three (3) facts.

First, the first sentence of the Application sets forth a claim of priority, but simply omits an explicit statement as to the relationship between the Application and U.S. Application No. 10/411,971.<sup>2</sup> The omission appears to be the result of a simple clerical error. Specifically, the Application states:

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<sup>2</sup> The first page of the Application is attached hereto as Exhibit A.

[0001] This application claims the benefit of U.S. Application No. 10/411,971, filed April 11, 2003, which claims priority to U.S. Application No. 09/641,363 filed on August 18, 2000, which claims priority to U.S. Provisional Application No. 60/149,740 filed on August 19, 1999, all of which are incorporated herein by reference.

Second, the Joint Declaration for Patent Application,<sup>3</sup> submitted with the Application on September 5, 2003 states that benefit was claimed to both a provisional application and pending non-provisional applications. Specifically, the Joint Declaration states a claim of benefit “under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below...” followed by the table:

Application Serial Number	Date of Filing (day, month, year)
60/149,740	19, August, 1999

The Joint Declaration then claims additional priority reaching back to the provisional “under Title 35, United States Code, §§ 120 and 365 of any United States application(s) listed below...”, setting forth the table:

Application Serial Number	Date of Filing (day, month, year)	Status - Patented, Pending, Abandoned
10/411,971	11, April, 2003	Pending
09/641,363	18, August, 2000	Pending

Again, while the specific relationship between the Application and U.S. Application No. 10/411,971 was not explicitly stated, such omission was inadvertent.

Third, the requirement to explicitly recite the relationship between a filed application and a parent application was a relatively new requirement when the Application was filed. Prior to February of 2003, all previous versions of the Manual of Patent Examining Procedure (“MPEP”) did not require this relationship to be explicitly stated. Such requirement was

<sup>3</sup> The Joint Declaration for Patent Application is attached hereto as Exhibit B.

introduced in Revision 1 of the Eighth Edition of the MPEP, published in February of 2003. The Application was filed on September 5, 2003. It appears that prior counsel inadvertently used an outdated form transmittal.

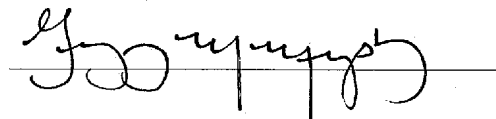
Accordingly, Applicants reasonably believed that a proper priority claim under 37 C.F.R. 1.78 had been provided. Within days of learning that the priority claims forth in (i) the specification of the Application; and (ii) the Joint Declaration might be considered insufficient, Applicants submitted the instant Petition.

\* \* \*

Based on the above, Applicants respectfully request that the Application be amended to recite priority under 35 U.S.C. 120 as set forth above. Should the Office have any questions or concerns it is invited to contact the undersigned at the number or email below.

Dated: September 27, 2010

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Gregory M. Murphy', written over a horizontal line.

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10/655,828  
*Attorney Docket No. 62941.002015*  
*Customer No. 94551*  
*Petition Under 37 C.F.R. 1.78(a)(3)*

# **APPENDIX I**

*September 27, 2010*



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

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MAILED

SEP 16 2010

In re Application of  
Graves et al.

Application No. 10/655,828

Filed: September 5, 2003

Attorney Docket No. 62941.002015

OFFICE OF PETITIONS

DECISION ON PETITION

UNDER 37 CFR 1.78(a)(3)

AND 37 CFR 1.78(a)(6)

This is a decision on the petitions under 37 CFR 1.78(a)(3) and 1.78(a)(6), filed July 8, 2010, to accept an unintentionally delayed claim under 35 U.S.C. § 120 and 119(e) for the benefit of priority to the prior-filed applications.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 119(e) 37 CFR §§1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

The amendment submitted concurrently with the instant petition as drafted is unacceptable and, therefore, is not considered a proper reference under 36 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i). In this regard, the amendment is physically part of the instant petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority) must commence on a separate physical sheet. 37 CF 1.4(c) states that each distinct subject, inquiry or order must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

In view of the above, the amendment to add a priority claim to the first line of the specification, which is physically embedded in the instant petition, is not acceptable.

Accordingly, a substitute amendment, in compliance with the aforementioned rules, along with a renewed petition under 37 CFR 1.78(a)(3), must be submitted.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Mail Stop PETITIONS  
                              Commissioner for Patents  
                              Post Office Box 1450  
                              Alexandria, VA 22313-1450

By hand:                   Customer Window located at:  
                              U.S. Patent and Trademark Office  
                              Customer Service Window Randolph Building  
                              401 Dulany Street  
                              Alexandria, VA 22314

By fax:                   (571) 273-8300  
                              ATTN: Office of Petitions

Any questions concerning this matter may be directed to Alicia Kelley at (571) 272-6059.

/Liana Walsh/  
Liana Walsh  
Petitions Examiner  
Office of Petitions

10/655,828  
*Attorney Docket No. 62941.002015*  
*Customer No. 94551*  
*Petition Under 37 C.F.R. 1.78(a)(3)*

# EXHIBIT A

*September 27, 2010*



**SYSTEM AND METHOD FOR SECURELY AUTHORIZING AND DISTRIBUTING  
STORED-VALUE CARD DATA**

**RELATED APPLICATIONS**

[0001] This application claims the benefit of the U.S. Application No. 10/411,971, filed April 11, 2003, which claims priority to U.S. Application No. 09/641,363 filed on August 18, 2000, which claims priority to U.S. Provisional Application No. 60/149,740 filed on August 19, 1999, all of which are incorporated herein by reference. This application is related to U.S. Application No. 10/253,243 filed on September 24, 2002 and International Application No. PCT/US02/30281 filed September 24, 2002, which claim priority to U.S. Provisional Application No. 60/396,404 filed July 15, 2002 and U.S. Provisional Application No. 60/324,333 filed September 24, 2001, which are all incorporated herein by reference.

**FIELD OF THE INVENTION**

[0002] The present invention is generally related to remote data authorization and distribution. More particularly, the present invention is related to a system and method for securely authorizing and distributing stored-value card data between a plurality of users and a central processor over a communications network.

**BACKGROUND OF THE INVENTION**

[0003] Stored-value cards can be authorized and distributed over communications networks. Examples of communications networks include dedicated telephone lines, public telephone links, and the internet or other networked communication. The data of the stored-value cards is related to services and/or products prepaid by the owner or end user of the card. Examples of prepaid services that may be accommodated by the stored-value data include long distance telephone communication, wireless communication, paging and internet-enabled communication services, including wireless web access. Other examples of prepaid services and/or products that may be accommodated by the stored-value card include gift cards, prepaid gas cards, prepaid grocery cards, prepaid entertainment cards, downloadable ring tone cards, downloadable game cards, downloadable music cards that use MP3, MP4, WMV, WAV, or other music formats, any other downloadable software card, customer rewards cards, and any other type of stored-value cards for products, services, or both, that may be prepaid by the owner of the card.

10/655,828  
*Attorney Docket No. 62941.002015*  
*Customer No. 94551*  
*Petition Under 37 C.F.R. 1.78(a)(3)*

# **EXHIBIT B**

*September 27, 2010*

**JOINT DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY**

As the below named inventors, we hereby declare that:

Our residences, post office addresses and citizenship are as stated below next to our names;

We believe that we are the original, first and joint inventors of the subject matter which is claimed and for which a patent is sought on the invention entitled **SYSTEM AND METHOD FOR SECURELY AUTHORIZING AND DISTRIBUTING STORED-VALUE CARD DATA**, the specification of which

- ☒ is attached hereto.  
☐ was filed on \_\_\_\_\_ as Application Number \_\_\_\_\_ and was amended on \_\_\_\_\_  
 (if applicable)  
☐ is an International Application, PCT Application No. \_\_\_\_\_ filed on \_\_\_\_\_

We hereby state that we have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to in this declaration.

We acknowledge the duty to disclose all information known to us to be material to the patentability of this application, as defined in 37 C.F.R. §1.56(a).

We acknowledge the duty to disclose to the Office all information known to us to be material to patentability as defined in § 1.56(a), which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

**Prior Foreign Application(s)**

We hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application(s) for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Country	Application Number	Date of Filing (day, month, year)	Date of Issue (day, month, year)	Priority Claimed Under 35 U.S.C. 119 Yes <input type="checkbox"/> No <input type="checkbox"/>

**Prior United States Provisional Application(s)**

We hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below

Application Serial Number	Date of Filing (day, month, year)
60/149,740	19, August, 1999

**Prior United States Application(s)**

We hereby claim the benefit under Title 35, United States Code, §§ 120 and 365 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, we acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

Application Serial Number	Date of Filing (day, month, year)	Status - Patented, Pending, Abandoned
10/411,971	11, April, 2003	Pending
09/641,363	18, August, 2000	Pending

And we hereby appoint, both jointly and severally, as our attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith the following attorneys, their registration numbers being listed after their names:

Stanislaus Aksman, Reg. No. 28,562; Jennifer A. Albert, Reg. No. 32,012; Thomas E. Anderson, Reg. No. 37,063; David E. Baker, Reg. No. 42,285; Carl L. Benson, Reg. No. 38,378; Thomas D. Bradshaw, Reg. No. 51,492; J. Robert Brown, Jr., Reg. No. 45,438; Brian M. Buroker, Reg. No. 39,125; Christopher C. Campbell, Reg. No. 37,291; Katherine S. Chang, Reg. No. 40,544; Robin C. Clark, Reg. No. 40,956; Trevor Q. Coddington, Reg. No. 46,633; Christopher J. Cuneo, Reg. No. 42,450; Ryan S. Davidson, Reg. No. 51,596; Patrick A. Doody, Reg. No. 35,022; Kevin T. Duncan, Reg. No. 41,495; Ozzie A. Farres, Reg. No. 43,606; Nancy J. Flint, Reg. No. 46,704; Christopher J. Forstner, Reg. No. 46,049; Charles F. Hollis, III, Reg. No. 40,650; Nancy J. Jensen, Reg. No. 45,913; Herbert V. Kerner, Reg. No. 42,721; Shawn K. Leppo, Reg. No. 50,311; Robert C. Lampe, III, Reg. No. 51,914; Jonathan D. Link, Reg. No. 41,548; Tyler Maddry, Reg. No. 40,074; J. Michael Martinez de Andino, Reg. No. 37,178; David H. Milligan, Reg. No. 42,893; James R. Miner, Reg. No. 40,444; Bryan F. Moore, Reg. No. 52,044; Jeffrey T. Perez, Reg. No. 52,110; Michael P.F. Phelps, Reg. No. 48,654; John P. Pinkerton, Reg. No. 28,746; Laurence H. Posorske, Reg. No. 34,698; Andrew J. Ririe, Reg. No. 45,597; Stephen T. Schreiner, Reg. No. 43,097; Robert M. Schulman, Reg. No. 31,196; Thomas J. Scott, Jr., Reg. No. 27,836; Yisun Song, Reg. No. 44,487; Shelley L. Spalding, Reg. No. 51,971; Rodger L. Tate, Reg. No. 27,399; Samson Vermont, Reg. No. 42,202; Robert J. Ward, Reg. No. 28,746; and Scott F. Yarnell, Reg. No. 45,245, all of Hunton & Williams; and

All correspondence and telephone communications should be addressed to:

CUSTOMER NUMBER

27682

PATENT TRADEMARK OFFICE

which corresponds to the address of J. Michael Martinez de Andino, Hunton & Williams, Riverfront Plaza, East Tower, 951 East Byrd Street, Richmond, VA 23219-4074, telephone number (804) 788-8200.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signature



Date: 9-3-2003

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Date:

9/3/03

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